### **REMARKS**

### 1. Status of the Claims and Claim Numbering

In the Notice, the Examiner asserts that the status of claims as indicated in Applicant's previously reply of November 11, 2008 is incorrect. Specifically, the Examiner alleges that the status of claims 40-42 is incorrect because only claims 1-39 were present in the amendment filed on April 21, 2008 (the "April 2008 Reply"). As explained below, in view of the history of claim amendments for this application, Applicant submits that the claim numbering in the April 2008 Reply amendments was erroneous. New claims 38 and 39 of the April 2008 Reply should have been numbered 41 and 42. The Office Action mailed on May 29, 2008, however, entered the amendments requested in the April 2008 Reply and thus sustained Applicant's erroneous numbering recognizing the presence of claims 1-39. Based on a correct accounting for claim numbering, Applicant submits that claims 21, 23, 35, 36, 41, and 42 are pending in this application. Claims 21, 23, 35, and 41 are allowed.

Shown below is an account of the pending and canceled claims during the prosecution history of this application. Only claim amendments that were entered are indicated.

Date	Pending Claims	Canceled Claims
08/28/03 (original claims)	1-20	None
09/13/06	21	1-20
09/21/06	21-40	1-20
05/09/07	21, 23-25, 27, 28, 35, 36	1-20, 22, 26, 29-34, <i>37-40</i>
10/01/07	21, 23-25, 27, 28, 35, 36	1-20, 22, 26, 29-34, <i>37-40</i>
04/21/08	21, 23, 35, 36, <i>38</i> , <i>39</i>	1-20, 22, 24-34, 37

As shown in the table, new claims 22-40 were introduced by Applicant's amendment of September 21, 2006. See Appendix A. These amendments were entered and then recognized in the Office Action mailed on November 9, 2006, which indicates pending claims 21-40. See Appendix B. Claims 37-40 were subsequently canceled in Applicant's amendment of May 9, 2007. See Appendix C. This amendment was entered and then recognized in the Office Action mailed on May 30, 2007, which indicates pending claims only up to claim 36. See Appendix D. The same claims, 21, 23-25, 27, 28, 35 and 36 were pending after Applicant's amendment of October 1, 2007, as indicated by the Office Action mailed on November 20, 2007. See Appendix E.

In view of this history, claims 1-40 have been present in the application since entry of the September 21, 2006 amendment, and Applicant's addition of new claims 38 and 39 in the April 2008

Docket No. 050992.0300.07USCP

Application No. 10/604,943

Reply was erroneous. See Appendix F. Claims 38 and 39 should have been numbered 41 and 42. To correct this erroneous numbering, as explained in Applicant's most recent November 11, 2008 reply, Applicant indicated claims 37-40 as being canceled, and new claims 38 and 39 from the April 2008 Reply as being number 41 and 42. Applicant submits that the claim status indications in April 2008 Reply showing claim 40 as canceled, 41 as previously presented, and 42 as currently amended, are accurate. In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the Notice and review the April 2008 Reply as filed.

### 2. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

POLSINELLI SHALTON FLANIGAN SUELTHAUS PC

Dated: February 9, 2009

On behalf of:

Teddy C. Scott, Jr., Ph.D.

Registration No. 53,573

By:

/Ron Galant, Ph.D./ Ron Galant, Ph.D. Registration No. 60,558 Customer No. 37808

POLSINELLI SHALTON FLANIGAN SUELTHAUS PC 180 N. Stetson Ave., Suite 4525 Chicago, IL 60601 312.819.1900 (main) 312.602.3955 (E-fax) 312.873.3613 (direct)

### APPENDIX A

Application No.: 10/604,943

Docket No.: 050992.0300.CPUS07

- 32. (new) The nucleic acid of claim 30, wherein the nucleic acid is capable of modulating expression of a target gene.
- 33. (new) The nucleic acid of claim 31, wherein the nucleic acid is at least 15/25 complementary to a binding site sequence of 18 to 24 nucleotides of a target gene and wherein the binding site sequence is located in an untranslated region of RNA encoded by the target gene.
- 34. (new) The nucleic acid of claim 32, wherein the nucleic acid is at least 15/25 complementary to a binding site sequence of 18 to 24 nucleotides of a target gene and wherein the binding site sequence is located in an untranslated region of RNA encoded by the target gene.
- 35. (new) A vector comprising an insert, wherein the insert consists of the nucleic acid of claim 21.
- 36. (new) A vector comprising an insert, wherein an insert consists of the nucleic acid of claim 25.
- 37. (new) A probe comprising insert, wherein an insert consists of the nucleic acid of claim 21.
- 38. (new) A probe comprising an insert, wherein an insert consists of the nucleic acid of claim 25.
- 39. (new) A gene expression inhibition system comprising the vector of claim 35 and a means for inserting said vector into a cell.
- 40. (new) A gene expression inhibition system comprising the vector of claim 36 and a means for inserting said vector into a cell.

## APPENDIX B



# UNITED STATES PATENT AND TRADEMARK OFFICE

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Kansas Cit	Y. MO 64112		DATE MAILED THOSEON	;

Please find below and/or attached an Office communication concerning this application or proceeding.

PTG-90C (Rev. 10/03)

	Application	No. Ap	plicant(c)		
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6) S Clamb) 21-49 is/ore rejected.					
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Application Papers					
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Priority under 35 U.S.C. § 119					
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### APPENDIX C

Application (Ju.: 10/604.943

Durka No.: 050392,9303,07USCP

#### AMENDMENTS TO THE CLAIMS

- 1. -20 (casceled)
- 21. (Currently Amended) An isotated nucleic acid consisting of 48-se-420 X modeonities wherein the sequence of the nucleic acid comprises:
  - (a) selected 16-Y concecutive nuclearides of SEQ ID NO. 3766 NOS. 128, 131, or 133:
  - (b) an RNA equivalent of (a);
  - (c) a suggestion at least 42/62(2,275 literation) to (a) or (b); or
  - (d) the complement of any one of (a)-(c),

wherein

X=18:0120.

YS IS and

X-Y.

- 21. (Carreles)
- 23. (Currently Amended) The notific acid of claim 21, wherein the objects 48X succeedings in the group constaints of SEQ ID NOS; 477, 480, and 482.
- 24 (Carrently Amended) The nucleic acid of claim 24, wherein the nucleic wild consists of  $\chi_{\pm}$ 18 to 14 nucleosides.
- 25. (Carrendy Amended) The nucleic acid of claim 21, wherein <u>XeY</u> the sequence of the two less acid coming of

an HNA aquivalent of (a);

(d)the complement of any are of (a) (a).

- 26. (Cancaled)
- 27 (Currently Amended) The nucleic acid of claim 2523, wherein XxX.90 at host 18 musteridae in a few analyses and the surface of the surface
- 28. (Currently Amended) The michaic hold of claim 25, wherein the author cald continue of X=18 to 24-modes) does.
  - 29. 34 (Canceled)
- 35. (Corrently Amended) A vector comprising as insure-wherein the insert-convision of the nucleic acid of claim 21.
- 36. (Currently Amended) A vector comprising an Insect-wherein an insect-consistent the nucleic acid of claim 25.

•<u>\*</u>2.

Application No.: 10/004,943

Docket No.: 050992,0300007USCP

37. -40 (Canceled)

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# APPENDIX D



## United States Patent and Trademark Office

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL/90A (Rev. 94/07)

	Application No	Applicant(s)			
	10/904,945	BENTWICH, IT	THAK		
Office Action Summary	Examiner	Art Units	<del></del>		
	Dana Shin	1635			
- The MAILING DATE of this communication ap Period for Reply	bears ou the con	r shoot with the correspondence	eddross		
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8) Claim(s) are subject to restriction and/	or election require	เกษกร.			
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11) The oath or declaration is objected to by the Examiner, Note the attached Office Action or form PTO-152.					
Priority under 35 U.S.C. § 119	Priority under 35 U.S.C. § 119				
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 118(a)-(d) or (i).  a  All b  Some 'c  None of:					
1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents have been received in Application No					
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application from the International Bureau (PCT Rule 17.2(e)).					
* See the attached detailed Office action for a list of the confilled copies not received.					
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# APPENDIX E



APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/604,943	09/28/2003	tuhak Benrwich	050902.0300.07USCP	1942
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rcv. 04/07)

		Application No.	Applicant(s)		
,			BENTWICH, ITZHAK		
Office Action Summary	ction Summary	10/604,943			
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Disposition of Claims					
4) (S) Claim(s) 21.2	<u>3-25 27,28.35 and 36</u> is/are po	anding in the application.			
4s) Of the abo	we claim(s) is/are withd	rewn from consideration.			
5) Claim(s)	is/are allowed.				
6) Claim(s) 21.2;	2-25,27,25,35 and 36 is/are re	jected.			
7) Ctaim(6)	_ is/are objected to.				
8) Claim(s)	_ are subject to restriction and	Ifor election requirement.			
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-			s objected to. See 37 CFR 1.121(d).		
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Priority under 35 U.S.C	C. § 119		•		
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### APPENDIX F

Application No. 107(01.94)

Docket No. 050992.0300.07USCP

#### AMENDMENTS TO THE CLAIMS

- 1. 20. (Canceled)
- 21. (Currently Amended) An isolated nucleic acid <del>consisting of X nucleotides</del> wherein the sequence of the nucleic acid <del>comprises</del> is selected from the group consisting of:
  - (a) Y-consecutive-nucleotides of SEQ ID NOS: 128, 131, or 133;
  - (b) an RNA equivalent encoded by the nucleic acid of (al; and
  - fe) o sequence at least 83.3% identical to (a) or (b): sr
  - (d)(c) the complement of any one of (a) (a) (a) or (b), wherein the complement is identical in length to (a) or (b),

X = 20 10 120.

Y = 20) to 120.

14 mm 15.

- 22. (Conceled)
- - (6) SEO ID NO 477, SEO ID NO 480, 6: SEQ ID NO 482;
  - 115) an RNA encoded by the mosfere acid of fall and
  - (c) the complement of (a) or (b), wherein the complement is identical in length to (a) or (b).
  - 24. 34. (Canceled)
  - 35. (Previously presented) A vector comprising the nucleic acid of claim 21.
  - 36. (Currently Amended) A vector comprising the nucleic acid of claim 25.23.
  - 37. (Canceled)
  - 38. (New) A probe comprising the nucleic anid of claha 21.
  - 39. (New) A probe comprising the recleic acid of claim 23.